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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 10/786,914   | 02/25/2004  | Akira Nakano         | 9281-4793               | 2084             |
| 757  | 7590        | 12/19/2005           | EXAMINER                |                  |
| BRINKS HOFER GILSON & LIONE<br>P.O. BOX 10395<br>CHICAGO, IL 60610 |             |                      | ALEJANDRO MULERO, LUZ L |                  |
|  |             |                      | ART UNIT                | PAPER NUMBER     |
|  |             |                      | 1763                    |                  |

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |               |  |
|------------------------------|------------------|---------------|--|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)  |  |
|                              | 10/786,914       | NAKANO ET AL. |  |
|                              | Examiner         | Art Unit      |  |
|                              | Luz L. Alejandro | 1763          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/442,539.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Reissue Applications***

#### **A) Written consent of all assignees**

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action, since the submitted written consent of all assignees owning an undivided interest in the patent (written consent) lists seven inventors (see the last paragraph of the written consent), however, the reissue application as well as the parent application have only six inventors. Furthermore, it should be noted that out of the seven names of the inventors listed in the written consent, only two names are correctly listed as the inventors and the other five names appear to be mistakenly listed as the inventors.

#### **B) Priority**

Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

The application does not properly claim foreign priority. Such a claim must be claimed in an Application Data Sheet or in the Oath/Declaration. The mention of the foreign priority in the preliminary amendment is not sufficient.

### **C) Declaration**

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. See, for example, MPEP 1412:

#### **FAILURE TO TIMELY FILE A DIVISIONAL APPLICATION PRIOR TO ISSUANCE OF ORIGINAL PATENT**

Where a restriction requirement was made in an application and applicant permitted the elected invention to issue as a patent without the filing of a divisional application on the non-elected invention(s), the non-elected invention(s) cannot be recovered by filing a reissue application. A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) in response to a restriction requirement is not considered to be error causing a patent granted on the elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim.

Accordingly, such error is not correctable by reissue of the original patent under 35 U.S.C. 251.

Claims 1-23 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

#### **D) Specification**

The disclosure is objected to because of the following informalities: the copy of the specification filed by applicants is improper in that it does not incorporate the changes made by the certificate of correction, see MPEP 1411.01 (note that the change made by certificate of correction cannot be done through a preliminary amendment).

A substitute specification is required. In order for the clean copy to be entered as a substitute specification, the reissue applicant must file a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1).

#### **E) Preliminary Amendment**


The preliminary amendment to claim 5 is improper in that it attempts to add the change made by certificate of correction (note that changes made by the certificate of correction should be included in the reissue application without underlying or bracketing, see MPEP 1411.01).

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luz L. Alejandro whose telephone number is 571-272-1430. The examiner can normally be reached on Monday to Thursday from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on 571-272-1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Luz L. Alejandro  
Primary Examiner  
Art Unit 1763

December 13, 2005